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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,388	11/20/2003	Truett P. Mills	TPM-43-CIP	9729
37923	7590	06/01/2004	EXAMINER	
ROBERTSON & MULLINAX, LLC PO BOX 26029 GREENVILLE, SC 29616-1029			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/718,388

Applicant(s)

MILLS, TRUETT P.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/20/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office action is responsive to communication received 11/20/2003 – application papers filed and IDS.

This application is a CIP of 10/154,114 filed 05/23/2002, now abandoned.

Claims 1-15 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fenton. As to claim 1, Fenton shows an iron-type club head having a front face (120) and an aperture (Figure 4), the aperture being substantially perpendicular to the plane of the face. As to claim 3, the heel face and plane of the

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striking face define a zero degree angle there between. As to claim 4, note element (28) in Figure 2 defining a wedge-shaped member. As to claim 5, the club head in Fenton includes a face, sole, toe and heel, with the heel including an aperture extending into the front face portion. The language, "adapted for receiving a hosel portion therein" is merely functional and does not further limit the structure of the golf club. As to claim 6, the aperture extends from a front surface of the heel portion. As to claim 8, Figures 7, 9, 12, 13, 14, 17 and 19 clearly indicate that the angle of the hosel inserted within the aperture in the front face establishes a loft angle for the club head.

Claims 10, 11, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang. Reference is made to Figure 3 depicting a prior art club head that includes a shaft (21), a hosel (20), a club head (2) and an aperture (not numbered) that is located within the heel section of the head and extends into the front surface of the head. The plane containing the heel is coplanar with the plane that defines a majority of the striking face portion. The bore appears to be oriented in a perpendicular fashion with respect to the face plane. As to claim 12, reference is made to Figures 7 and 10, wherein the bore or recess (41) is contained in a plane that is coplanar with a plane (40) that houses the striking face.

Claims 1-3, 5, 6, 10, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Koide. Specific to claims 1-3, Figures 8 and 9 show an aperture (not numbered) for receiving a shaft (21) and hosel (12). As to claim 3, as the heel plane and striking face plane are coplanar, the angle there between is zero. As to claims 5, 6, 10, 11 and 15, reference is made to Figure 5 and a showing from Koide of a shaft (21),

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hosel (12) and an angle between the bore in the face and the hosel that is not perpendicular to the plane of the face. See Figures 8 and 9, wherein the aperture in the front striking face is clearly shown.

Claims 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Neher. Reference is made to Figure 1, wherein an aperture is shown as extending through the front face and the rear face of the heel. The aperture (19) may receive stem (31) that is attached to hosel (5).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Huang or Koide. To have modified the device in either of the reference to Huang or Koide to provide a heel face plane that intersects the front face plane of the head in order to change the loft and/or of the head would have simply involved an obvious design choice on the part of the skilled artisan, since it is not seen the rearrangement of the hosel and striking face would serve any new or unobvious purpose. Further, the applicant has not detailed that this claimed arrangement would have solved any stated problem in the art. The arrangement of planes, i.e., coplanar, parallel, intersecting between the heel face and the striking face would have simply enabled the angle of the head to be altered and make the club head more versatile, such would have been obvious considering that clubs are commonly provided with varying loft and/or lie for personalizing the head to a specific golfer's needs.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yim and Goodwin show hosel connections, of interest.


All references cited during prosecution of applicant's parent application are deemed pertinent to this application and are incorporated herein by reference.

Applicant is respectfully requested to maintain a clear line of demarcation among each of the instant claims and the claims of U.S. Patent Nos: 6,648,771 and 6,319,146 in order to avoid the need to address any issues of double patenting during prosecution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
May 27, 2004